

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Public Advisory Committee Quarterly Meeting

International Update

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May 14, 2015

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Topics for Today

- **Hague Agreement Implementation – Mr. Charles Pearson**
- **Search Collaboration Pilots – Ms. Amber Ostrup**

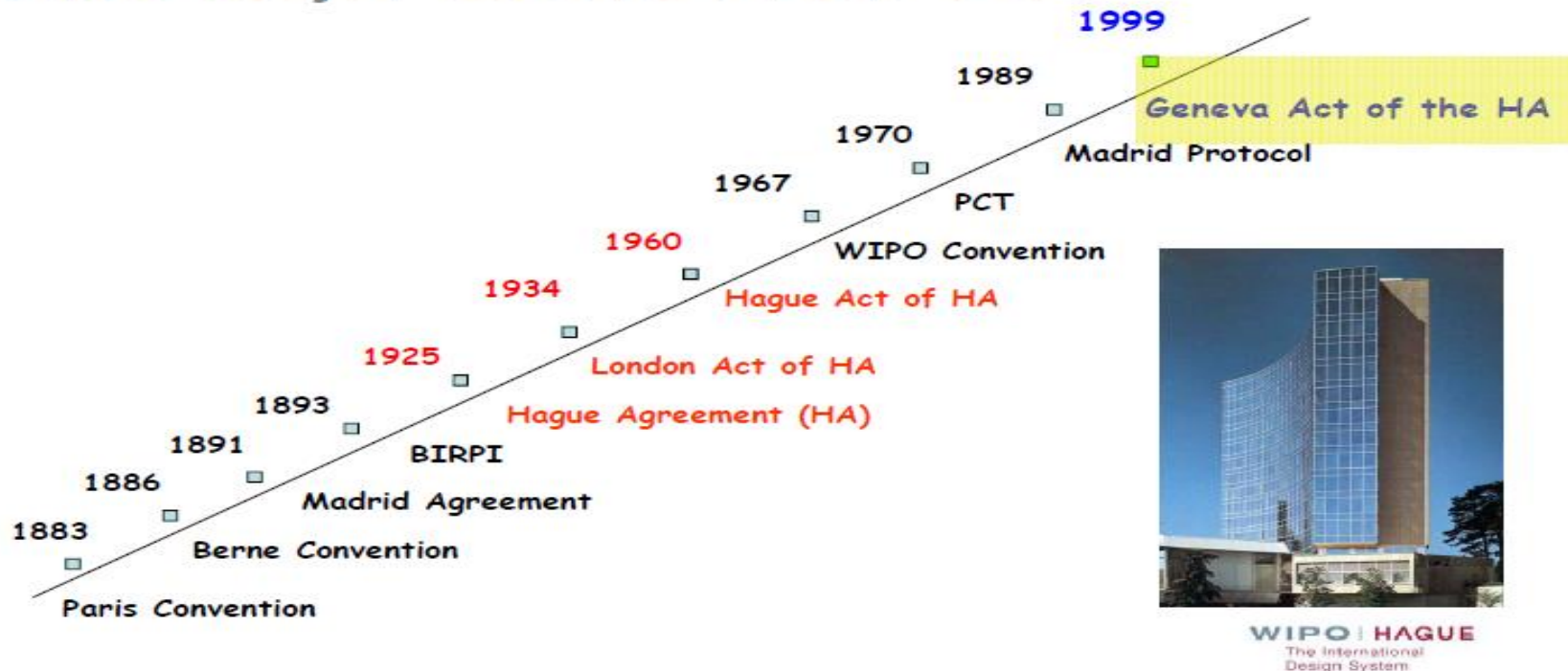
What are Designs?

- U.S. issues a “Design Patent”
- Ornamental design for an article of manufacture
- Protects only the appearance of an article, not structural or functional features
- Subject matter of an application may relate to:
 - Configuration or shape of article
 - Surface ornamentation applied to an article

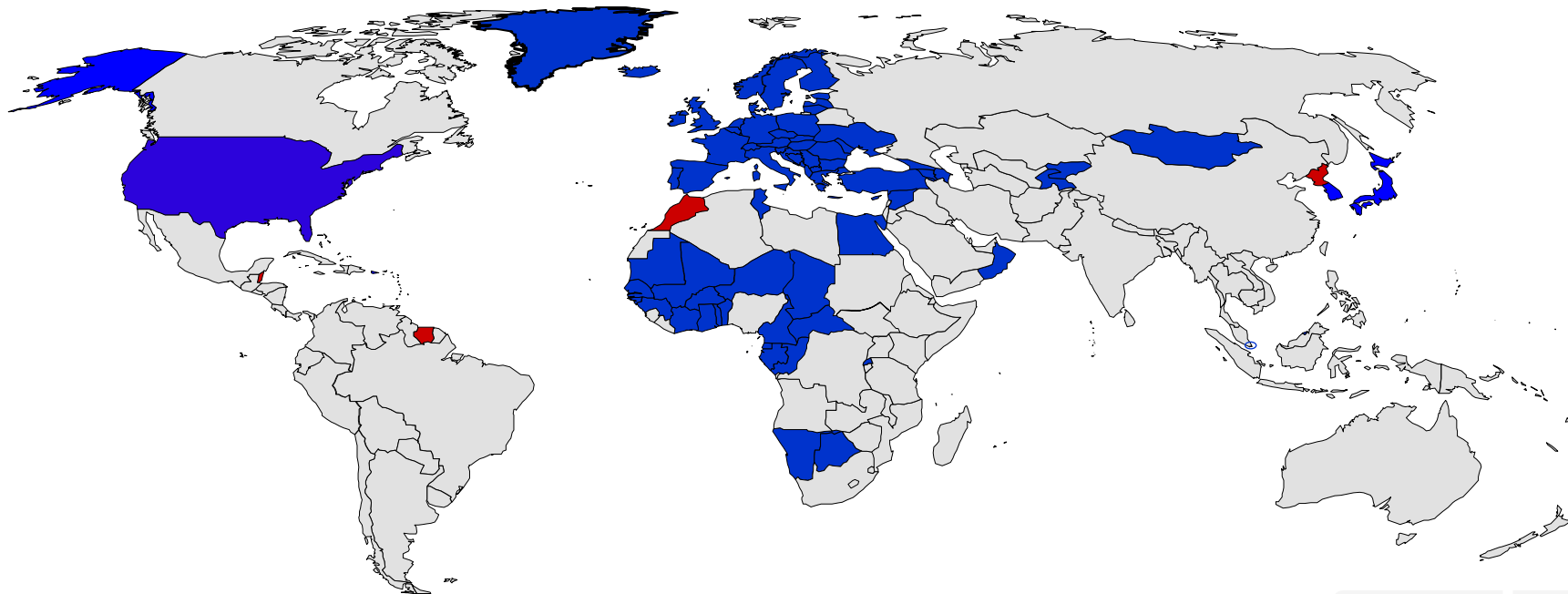
Hague System: Basic Concept

- The centralized acquisition and maintenance of industrial design rights
 - by filing a single international application
 - for a single international registration
 - with effect in one or more designated Contracting Parties.

Hague System and Other Major Events From 1883



Hague Union



47 Geneva Act (1999) (including EU and OAPI)

15 Hague Act (1960)

62 Contracting Parties (Soon to be 64)

Road to U.S. Membership

- **July 6, 1999** – United States signed Agreement
- **December 7, 2007** – The Senate considered; Advice and consent to ratification agreed to in Senate
- **December 18, 2012** – Pres. Obama signed into law the Patent Law Treaties Implementation Act of 2012
- **February 13, 2015** – Instrument of Ratification deposited with WIPO
- **April 2, 2015** – Final Rules Published
- **May 13, 2015** – Hague Agreement effective in U.S.

Illustrative Statistics and Figures

WIPO:

- 2924 International Applications in 2014
- 14,441 Designs covered in 2014

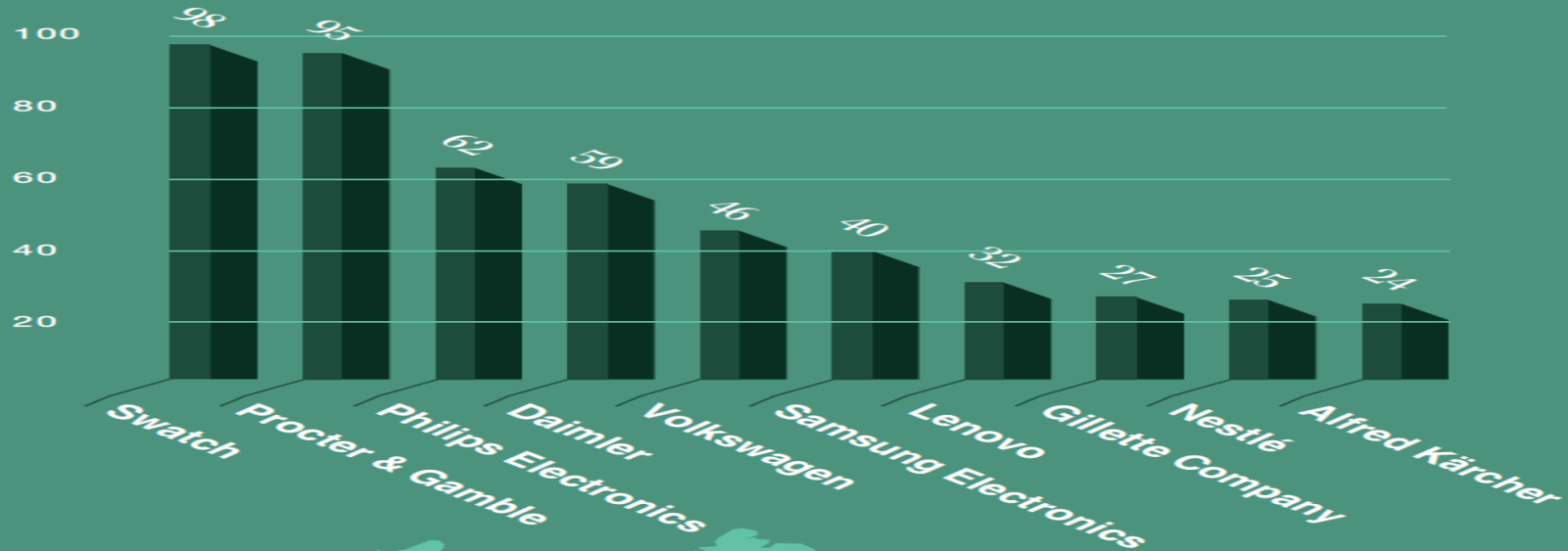
USPTO:

- 36,254 US design applns. filed in FY 2014
- 24,008 US design patents issued in FY 2014

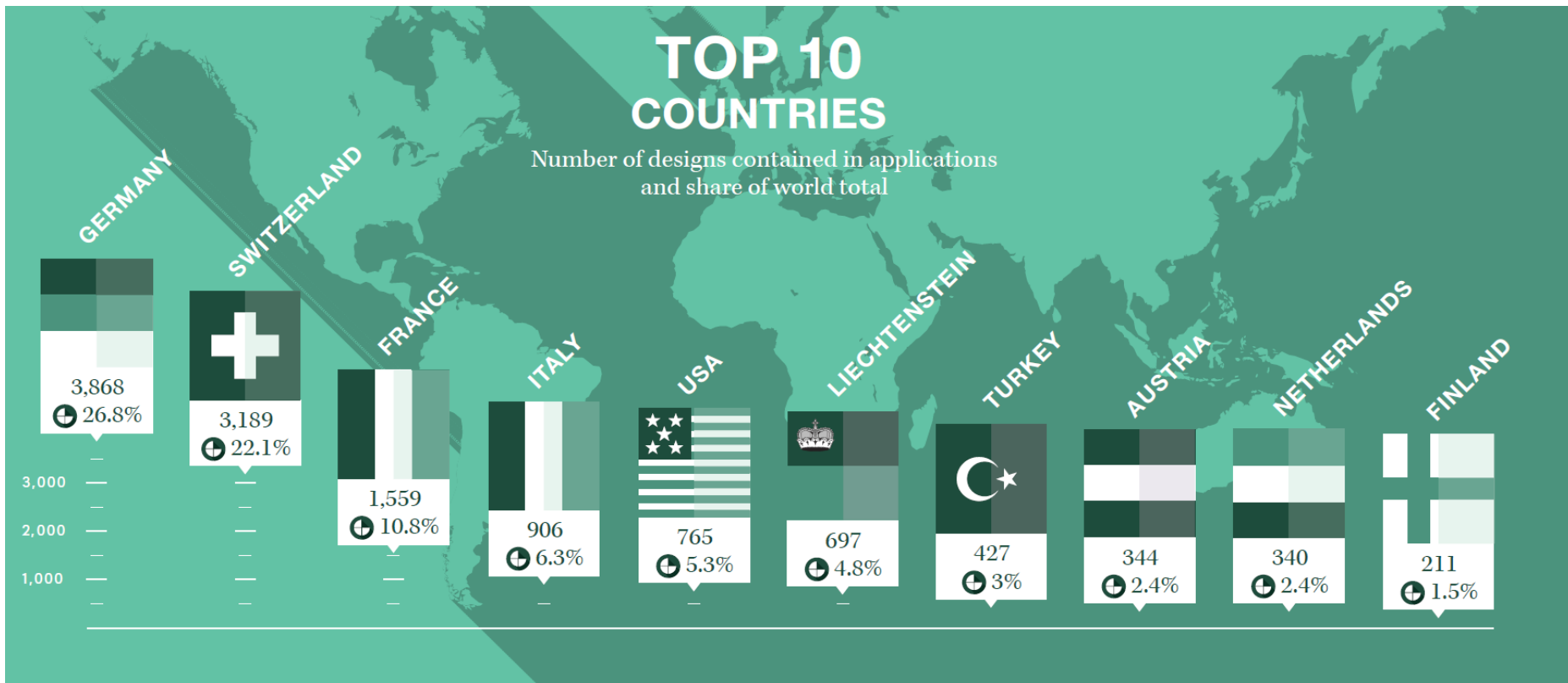
Illustrative Statistics and Figures

TOP 10 HAGUE APPLICANTS

Number of Hague applications
filed in 2014



Illustrative Statistics and Figures



What is the Hague System?

- A single international application for a single international registration (IR) in which one or more Contracting Parties (CP) are designated
- If no refusal, the resulting international registration has the effect of a grant of protection in each designated Contracting Party

...And What it is Not

- Since the Hague System is primarily a procedural arrangement, it does not determine:
 - the conditions for protection;
 - the refusal procedure to be applied when deciding whether a design may be protected; or
 - the rights which result from protection.
- Such issues are governed by the law of each Contracting Party designated in an international registration.

Who can Use the System?

You need

- An attachment to a Contracting Party
 - Nationality
 - Domicile
 - Real and effective industrial or commercial establishment
 - Habitual residence

Filing an International Application

- Language: English, French, or Spanish
- Directly with WIPO, electronically or on paper
- Indirectly through USPTO
- Up to 100 different designs (same Locarno class)
- Single set of formal requirements apply
- Single set of international fees can be paid to WIPO (CHF)



Filing an International Application Through the USPTO

- The applicant must have a U.S. attachment
 - U.S. must be “Applicant’s Contracting Party”
- Must pay a transmittal fee (\$120) to the USPTO
- International fees required by WIPO may be paid through USPTO or directly to WIPO
 - Payment through USPTO must be on/before date of payment of transmittal fee



Contents of an IDA

- Official form (DM/1 or equivalent)
 - Available at <http://www.wipo.int/hague/en/forms/>
- Reproductions (drawings)
- Annex(es)
 - Dependent upon designations. Available on WIPO website

Role of International Bureau (IB)

- World Intellectual Property Organization (WIPO)
- Examination of Formalities
- Translation into two other languages
- Recording of the IR in the International Register
- Crediting of designation fees to accounts of CPs
- Publication in the International Designs Bulletin
 - every Friday on WIPO's website

<http://www.wipo.int/hague/en/bulletin/haguebulletin/index.jsp>



Procedure at Designated Examining CP

- **Normal Substantive Examination by Office:**
 - To the extent it applies to national filings
 - Formalities examination is skipped
 - Statement of Grant of Protection may be issued
- **Possible Refusal:**
 - Made on same substantive grounds as for regular national filings
 - Communicated in time limit (U.S. 12 months)

Effects of IR under Geneva Act

- **Article 14(1):**
 - Effect as a regularly-filed application from the date of International Registration
- **Final Rules published in Federal Register on April 2, 2015**
- **Hague Agreement will become effective in U.S. on May 13, 2015**

Final Rules

- New subpart I in 37 CFR part I specific to international design applications (IDA)
 - USPTO as an office of indirect filing
 - Form and content requirements
 - National processing provisions
- Changes to various existing rules to accommodate IDAs

New Subpart I - § 1.1011

Applicant

Applicants - U.S. examination phase:

- If U.S. is designated, the IDA may be refused in the U.S. examination phase if the applicant is not:
 - Sole or joint inventors
 - Legal representative of deceased or legally incapacitated inventor
 - Assignee/obligated assignee/person having sufficient proprietary interest

New Subpart I - § 1.1021

Contents

§ 1.1021 sets forth:

- Mandatory and optional contents for IDAs
- Certain requirements where the U.S. is designated
 - Claim
 - Indications concerning the identity of the creator(s)
 - Inventor's oath or declaration

New Subpart I - § 1.1023

Filing Date in the United States

- The filing date of an IDA in the United States is the international registration date
- Provides for review of the filing date upon petition. The petition must include:
 1. A showing that the IDA is entitled to the requested filing date, and
 2. Petition fee (§ 1.17(f))

New Subpart I - Examination

- 37 CFR 1.1062
- Examination pursuant to Title 35 U.S.C.
- *Timing: Any notification of refusal* to be sent to the IB within 12 months from publication of the IR
 - Exception where delay was unintentional

- § 1.155 - the “rocket docket” procedure is available in an IDA

Additional Items

- 15 year patent term for designs
 - Applies to patents issuing from IDAs and domestic U.S. design applications filed on or after May 13
- U.S. design patent rights begin upon issuance of patent
- Provisional rights may start upon publication of the international registration by IB
- Color Drawings

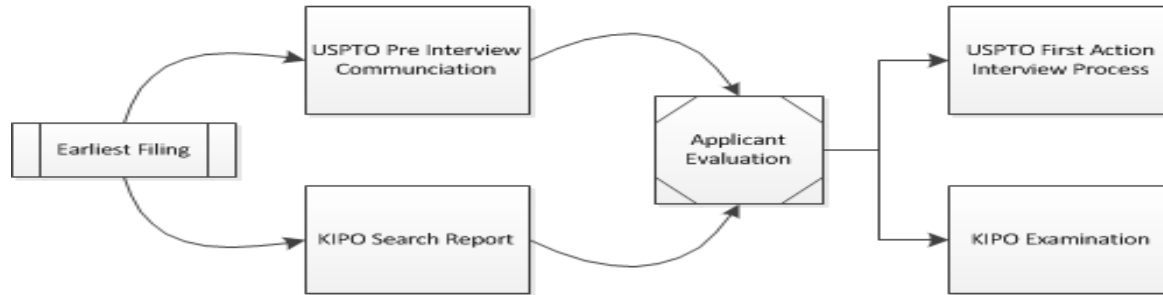
International Work Sharing Collaborative Search Pilots (CSP)

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New Pilot Comparisons

KIPO Pilot – Parallel Search and Evaluation Prior to Examination



JPO Pilot – Serial Search and Evaluation Prior to Examination



New Collaborative Search Pilots

Parallel Pilots testing prosecution efficiencies taking different approaches to initial search and examination

- JPO – **Serial search** on substantially similar claims prior to Pre Interview Communication
- KIPO – **Parallel search** on substantially similar claims
 - Both office's searches sent to applicant for consideration in response to Pre Interview Communication

Collaborative Search Pilots (CSP)

- Applications made special for first action
- Based on First Action Interview (FAI) Program
 - Claim Limits – 3 Independent/20 Total
 - Claim Matching –claims must correspond (slight difference between JPO and KIPO)
- Applicant Requirements:
 - Petition in both offices
 - Applicant consents to permit the USPTO and its partner offices to share information with partner offices under portions of 35 USC 122
 - (a) for sending to KIPO search results from unpublished US Applications
 - (c) & (e) for receiving KIPO/JPO search results and commentary in published US applications
- Pilot Duration is Two Years
 - **JPO Pilot begins August 1, 2015**
 - 200 applications per year per office of first search
 - **KIPO Pilot begins September 1, 2015**
 - 200 applications for each office of earliest priority

Collaborative Search Pilots (CSP)

Timeline

- Memorandum of Understanding (MOU) signed with POPA on 5/11/15
- Memorandum of Cooperation (MOC) with JPO and KIPO will be signed at IP5 Heads/Deputy Heads Meeting 5/20 (KIPO) and 5/21 (JPO)
- Press Release on 5/22
- Federal Register Notice 6/1
- Testing/Implementation May-July
 - JPO Pilot begins August 1, 2015
 - KIPO Pilot begins September 1, 2015

Questions and Comments

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